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EXAMINER

BASOM, BLAINE T

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/062,102
Filing Date: January 31, 2002
Appellant(s): BATES ET AL.

Hunter E. Webb
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 30, 2009 appealing from the Office action mailed December 1, 2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,664,210	FLEMING et al.	09-1997
WO 0129709 A1	HUSSAM, Ali	04-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims¹:

Claim Rejections - 35 USC § 102

Claims 1 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,664,210 to Fleming et al. (hereinafter “Fleming”). In general, Fleming describes a method and system that provides for multiple selections of text while supporting “swipe and type” operations (see e.g. column 2, lines 5-29).

Specifically regarding claim 1, Fleming teaches: selecting a first set of data (e.g. a first “portion” of text) within an application (see e.g. column 7, lines 23-38, and lines 49-67); and

¹ The Final Office Action, mailed on December 1, 2008, rejected claims 1 and 9, inter alia, under 35 U.S.C. §102(a) as anticipated by the U.S. Patent to Flemming et al. The final rejection also rejected claims 4, 6, 10 and 13, inter alia, under 35 U.S.C. §103(a) over Flemming in view of the W.O. Patent Publication to Hussam et al. In their after final amendments filed on February 26, 2009, the Appellants amended independent claims 1 and 9 to incorporate the subject matter of dependent claims 6 and 13, respectively, and cancelled all other claims. A such, independent claims 1 and 9, rejected under 35 U.S.C. §102(a) in the Final Rejection, currently incorporate subject matter from claims 6 and 13, respectively, which were rejected under 35 U.S.C. §103(a) in the Final Rejection. To keep the grounds of rejection consistent with the Final Rejection, the Examiner here presents the rejection for claims 1, 6, 9, and 13, as presented in the final rejection, and also the rejections for claims 4 and 10 (the rejection for claims 4 and 10 are closely associated with the rejections for claims 6 and 13, and are presented here for purposes of clarification). The Examiner respectfully notes, however, that claim 1 in its current, after final form is equivalent to

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selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5). Fleming thus teaches a method like that of claim 1, which is for selecting multiple sets of data in an application.

With respect to claim 9, Fleming teaches: providing an application (e.g. a word processor) for manipulating data (see e.g. column 1, lines 12-23; and column 2, lines 8-22); selecting a first set of data (e.g. a first “portion” of text) within the application (see e.g. column 7, lines 23-38, and lines 49-67); performing a first predetermined keystroke (i.e. via an augmentation key”) after selecting the first set of data (see column 7, lines 64-67); and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5). Fleming thus teaches a method like that of claim 9, which is for selecting multiple sets of data in an application.

Claim Rejections - 35 USC § 103

Claims 4, 6, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Fleming, which is described above, and also over PCT Application Publication No. WO 01/29707 A1 to Hussam (hereinafter “Hussam”).

claim 6, as rejected here and in the Final Office Action, and that claim 9 in its current, after final form is equivalent to claim 13 as rejected here and in the Final Office Action.

Specifically regarding claim 4, Fleming teaches a method like that of claim 1, in which a user can select multiple, non-contiguous sets of data in an application, as is described above (see e.g. the rejection for claim 1). Fleming, however, does not explicitly disclose that the user can further select within the same window of the application from which the selected sets of data were selected, in a distinctive manner, a first portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portion, as is recited in claim 4. Nevertheless, selecting a portion of a selected set of data is known in the art.

For example, Hussam demonstrates selecting (i.e. highlighting) within an application window multiple sets of data, and whereby the user can further select (i.e. highlight) within the same window of the application, in a distinctive manner (i.e. in a different color highlight), a first portion (i.e. an overlapping portion) of one of the selected sets of data, wherein the one of the selected sets of data remains selected during the selection of the first portion (see e.g. page 6, lines 3-15; page 33, lines 1-29; page 36, line 29 – page 37, line 2; page 44, lines 1-16; and page 54, lines 12-30).

It would have been obvious to one of ordinary skill in the art, having the teachings of Fleming and Hussam before him at the time the invention was made, to modify the application taught by Fleming to include the ability to select portions of already-selected sets of data (i.e. to select overlapping portions), like taught by Hussam. It would have been advantageous to one of ordinary skill to utilize this combination, because a given portion of data can be applicable to multiple sets, as is suggested by Hussam (see e.g. page 36, line 29 – page 37, line 2). Fleming and Hussam thus teach – to one of ordinary skill in the art – a method like that of claim 4.

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As per claim 6, Hussam teaches allowing a user to select multiple sets of data, including allowing selection of a second set of data that overlaps a first set of data (see e.g. page 6, lines 3-15; page 33, lines 1-29; page 36, line 29 – page 37, line 2; page 44, lines 1-16; and page 54, lines 12-30). The above-described combination of Fleming and Hussam is thus further considered to teach a method like that of claim 6.

Regarding claim 10, Fleming teaches a method like that of claim 9, in which a user can select multiple, non-contiguous sets of data in an application, as is described above (see e.g. the rejection for claim 9). Fleming, however, does not explicitly disclose that the user can further select, in a distinctive manner, a first and second portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portions, as is expressed in claim 10. Nevertheless, as described above (see e.g. the rejections for claim 4 and 5), Hussam teaches selecting, in a distinctive manner, a first and second portions of a selected set of data in a same window of the application from which the selected sets of data were selected, wherein the selected set of data remains selected during selection of the first portion and second portions. As further described above (see e.g. the rejections for claims 4 and 5) the combination of Hussam and Fleming also teaches performing a predetermined keystroke, and selecting the second portion of the one of the selected sets of data, wherein the first portion remains selected during the selection of the second portion based upon the predetermined keystroke. Accordingly, the above-described combination of Fleming and Hussam teaches – to one of ordinary skill in the art – a method like that of claim 10.

As per claim 13, Hussam teaches allowing a user to select multiple sets of data, including allowing selection of a second set of data that overlaps a first set of data (see e.g. page 6, lines 3-

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15; page 33, lines 1-29; page 36, line 29 – page 37, line 2; page 44, lines 1-16; and page 54, lines 12-30). The above-described combination of Fleming and Hussam is thus further considered to teach a method like that of claim 13.

(10) Response to Argument

Regarding claims 1 and 9, the Appellants argue that Hussam does not teach selection of a second set of data that overlaps a first selected set of data; the Appellants submit that in Hussam, one set of data is entirely within the other, and are thus not overlapping like claimed. The Examiner, however, respectfully disagrees with the Appellants arguments.

A second set of selected data that exists entirely within a first set of selected data, as done by Hussam, can be considered to be overlapped by the first set of data (i.e. the second set is *completely* overlapped by the first set), given the broadest, most reasonable interpretation of “overlap.” Conversely, the second set can be considered to overlap the first set of data (i.e. the second set *partially* overlaps the first set). Such interpretations of Hussam’s teachings are consistent with the specification. The specification does not provide any definition of the word “overlap,” and does not describe selecting multiple overlapping sets of data that each have portions that are outside the other. The specification on the other hand does provide an example of selecting two overlapping sets of data, referred to as e.g. “second level selection,” whereby one sets completely overlaps a second (see e.g. page 11, line 9 - page 12, line 6). As asserted by the Appellant, Hussam discloses one set of selected data that is entirely within another set of selected data. Thus, like the Appellants’ specification, Hussam teaches selection of a second set of data that overlaps a first selected set of data.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Blaine Basom/

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11/09/2009

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